

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

REMARKS

Applicants thank the Examiner for the detailed Office Action dated August 31, 2005. Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 1-5, 8-14, and 16-38 were pending in the application. Claims 1-5, 8-12, 16-19, 23-24, 26, 29-30, and 32-38 are currently being amended. After amending the claims as set forth above, claims 1-5, 8-14, and 16-38 remain pending in this application. One or more of the claims has been amended to recite one or more plurality of statements (e.g., first plurality of statements, second plurality of statements, etc.). Applicants note that the recited plurality of statements are intended to be non-exclusive, i.e., a particular statement may be part of two or more of the recited plurality of statements if the recited conditions are met (e.g., a particular statement may be included in both the first plurality of statements and the second plurality of statements).

For simplicity and clarity purposes in responding to the Office Action, Applicants' remarks are primarily focused on the rejections to the independent claims outlined in the Office Action with the understanding that the dependent claims that depend from the independent claims are patentable for at least the same reasons (and in most cases other reasons) that the independent claims are patentable. Applicants expressly reserve the right to argue the patentability of the dependent claims separately in any future proceedings.

Claim Rejections -- 35 U.S.C. § 102***Law of Anticipation***

The PTO acknowledges the legal standard that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, the "identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226,

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP § 2131. In general, in deciding the issue of anticipation, the trier of fact must identify the elements of the claim at issue, determine their meaning in light of the specification, and identify corresponding elements disclosed in the allegedly anticipating reference. Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ, 481, 485 (Fed. Cir. 1984).

In cases where there is no express description of a claimed invention and the anticipation rejection is based on the doctrine of inherency, MPEP § 2112 sets forth the following basic principles that govern PTO practice:

(1) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

(2) "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

(3) "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Independent Claim 18

On page 6 of the Office Action, independent claim 18 was rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,024,571 (Renegar). Applicants respectfully traverse the rejection. Renegar does not identically disclose Applicants' invention as claimed.

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Renegar shows a "a hand-held paper-based translation system" where "linguistic content is sequentially displayed to facilitate a step-by-step process for simple sentence-generation and customary conversational exchanges." (Renegar, abstract.) The system includes a "primary display surface (approximately 13 by 8 ½ inches)" that "folds horizontally and vertically, creating distinct quadrants." (Id.) "Tab-indexed sheets affixed to the primary surface provide display areas for expanded-content." (Id.)

Renegar does not identically disclose the combination of elements recited in independent claim 18, as amended. For example, Renegar does not disclose "the first medical statement being associated with a first grammatical characteristic identifier" and "the second medical statement being associated with a second grammatical characteristic identifier" as recited in independent claim 18. In the Final Office Action, the Patent Office asserts that "Renegar discloses that words are grouped according to function (verbs, adjectives, nouns, etc.) and the groupings are used to select words (column 11, lines 25-44) to assemble into a text block (construct sentences)." (Final Office Action, dated August 31, 2005, pg. 2.) Applicants respectfully disagree. Applicants note that the portion of Renegar referred to as supporting the Patent Office's assertion that words are grouped according to function (i.e., col. 11, lines 25-44) is actually describing how words were grouped in previous translation systems. Renegar distinguishes these earlier translation systems as consuming space unnecessarily and as being difficult to locate words. (Renegar, col. 11, lines 32-36.) Rather than using the traditional way of organizing words according to function (i.e., nouns, verbs, adjectives, adverbs, prepositions, conjunctions, etc.), Renegar uses a novel method for grouping and categorizing words that results in a composite of select support words 25 being listed in the lower-right quadrant 14 that includes many different types of speech such as adverbs, adjectives, prepositions, pronouns, conjunctions, etc. (Renegar, col. 11, lines 37-44.) Thus Renegar describes populating the lower right quadrant 14 with words that are not grouped by grammatical characteristics. Thus, in the passage cited by the Patent Office, Renegar is teaching away from grouping words according to function such as nouns, verbs, adjectives, adverbs, prepositions, conjunctions, etc.

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Applicants further submit that Renegar does not identically disclose "accessing a first medical statement from a statement library stored in a computer readable database" or "accessing a second medical statement from the statement library" as recited in amended independent claim 18. Applicants note that the focus of Renegar is on a hand-held paper-based translation system, not on a computer implemented system. (Renegar, abstract.) In fact, Renegar criticizes computer based translation systems because they "provide no fixed visual-aids, since displays of words are cleared after each usage." (Renegar, col. 38, lines 51-53.) "In contrast, the present invention provides permanent displays, some of which are constantly visible. This interjects in the learning experience a stabilizing influence that favorably impacts visual memory." (Renegar, col. 38, lines 53-57.) Applicants note that although Renegar discloses that "the present translation system may also be presented via a variety of other media including computer programs, slides, posters, books, overhead-projection systems, video cassettes, laser disks, compact disks, transparencies, posters, flip charts, and the like," (Renegar, col. 38, line 67 to col. 39, line 5.) it is not necessarily the case that it would be implemented in the form of a statement library that is stored in a computer readable database as recited in independent claim 18. Rather, given Renegar's repeated emphasis on the visually oriented nature of the system, a computer implemented version may be likely to consist of a number of stored images that are similar or identical to the paper pages shown in the Figures. Applicants respectfully note that should the Patent Office reject independent claim 18 based on Renegar's statement that the translation system may be presented via a computer program, the Patent Office is required to make the necessary findings to show a statement library stored in a computer readable database is necessarily present. (See Law of Anticipation discussion above).

Applicants respectfully submit that independent claim 18 and the claims which are dependent thereon are not anticipated by Renegar under 35 U.S.C. § 102(e) and are patentable.

Independent Claim 26

On page 7 of the Office Action, independent claim 26 and various dependent claims were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,292,796

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

(Drucker et al.). Applicants respectfully traverse the rejection. Drucker et al. does not identically disclose Applicants' invention as claimed.

Drucker et al. shows a method and apparatus for improving access to literature. (Drucker et al., abstract.) "Embodiments of the invention comprise an access mechanism that searches current and past literature (e.g., journal publications or other articles) and selects some or all of the literature for a user based on criteria established for the user. In one embodiment of the invention, the access mechanism is coupled to an electronic medical records system used to enter patient information and user profile information and coupled to one or more literature (e.g., medical, scientific, current affairs, law, dental, etc.) libraries or database(s). Search criteria is obtained from user profile information established for a physician (or other user of the electronic medical records system) and patient information. The search criteria is used to generate a request for literature from the libraries. The search criteria may act as a filter of the literature that is contained in a library. In addition, the results of the request obtained from a library may be filtered based on criteria established for the user. The user may view, save, and/or print the results." (Id.) Drucker et al. provides different types of searching including: record link, standing search, and ad hoc access. (Drucker et al., col. 4, lines 36-52.) A record link is coupled to a patient's chart in the electronic medical records system. (Id.) A search is performed whenever a user enters the patient's chart. (Id.) The search criteria may include fields in the patient's chart. (Id.) A standing search allows the user to setup and perform a search without accessing a patient's chart. (Id.) Ad hoc access allows the user to perform a search at any time using information contained in the patient's chart. (Id.)

Drucker et al. does not identically disclose the combination of elements recited in independent claim 26, as amended. As described in the preceding paragraph, Drucker et al. allows different types of searching to be performed such as a record link, a standing search, or ad hoc access. (Drucker et al., col. 4, lines 36-52.) The criteria for each of these searches is input during user setup (e.g., journals to search, time frame). (Drucker et al., col. 6, line 56 to col. 7, line 27; col. 8, lines 1-8; Figure 4.) Additional criteria may be obtained from values of specified fields of a patient's chart in record link and/or ad hoc access searches. (Id.) The results of any

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

of these searches may be filtered by journal, time frame (if these were not included previously in the original search criteria), or whether the user has already viewed the articles. (Drucker et al., col. 8, lines 9-17.)

Assuming for arguments sake that Drucker et al.'s use of the fields from a patient's chart in the record link and ad hoc searches satisfies the "selecting a first medical statement from a medical statement library stored in a computer readable database" limitation recited in independent claim 26, Drucker et al. still does not provide "access to a plurality of filtered medical statements which are filtered from the medical statement library using at least one of a grammatical characteristic of the first medical statement, a keyword associated with the first medical statement, an acronym associated with the first medical statement, or an identifier associated with a group of medical statements." The only criteria that Applicants have been able to find in Drucker et al. that is use to filter the initial search results is journal, time frame, and whether the articles were previously viewed by the user. (Drucker et al., col. 8, lines 9-17.)

The Patent Office cites various passages in Drucker et al. (i.e., col. 5, lines 47-51; col. 7, lines 37-42 and 51-65; and col. 8, lines 18-34) to support its argument that Drucker et al. discloses the "providing to the user access to a plurality of filtered medical statements . . ." limitation recited in independent claim 26. However, Applicants respectfully submit that none of these passages supports the Patent Office's position.

The passage in column 5 relied on by the Patent Office merely states that unspecified embodiments of the invention may be used with other types of systems such as a case management system used in the legal field as well as any other system that contains keywords that may be used to search literature libraries and/or databases. This statement does not disclose providing access to a plurality of filtered medical statements as recited in independent claim 26.

The passages relied on in col. 7 likewise do not disclose providing access to a plurality of filtered medical statements as recited in independent claim 26. The passage at col. 7, lines 37-42 is simply stating that the initial record link search, which used the fields from the patient's record as criteria for the search, may be filtered. The filtering is described further in col. 8, lines 9-17.

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Likewise, the passage at col. 7, lines 51-65 is referring to the initial search setup for a standing search. The standing search may initially be performed using natural language that can be parsed into keywords, dates, or sources. This passage is not referring to filtering of the initial search results.

The passage relied on in col. 8 describes the various ways that the user may be notified should one of the searches return a result. This passage also does not disclose providing access to a plurality of filtered medical statements as recited in independent claim 26.

Applicants further submit that Drucker et al. not only does not show the limitation that recites "providing to the user access to a plurality of filtered medical statements . . .," Drucker et al. also does not show "selecting a second medical statement from the plurality of filtered medical statements" also recited in independent claim 26.

Applicants respectfully submit that independent claim 26 and the claims which are dependent thereon are not anticipated by Drucker et al. under 35 U.S.C. § 102(e) and are patentable.

Independent Claim 30

On page 8 of the Office Action, independent claim 30 and various dependent claims were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,769,074 (Barnhill et al.). Applicants respectfully traverse the rejection. Barnhill et al. does not identically disclose Applicants' invention as claimed.

Barnhill et al. shows a "simultaneous multi access reasoning technology system" which "utilizes both existing knowledge and implicit information that can be numerically extracted from training data to provide a method and apparatus for diagnosing disease and treating a patient." (Barnhill et al., abstract). The technology in Barnhill et al. "further comprises a system for receiving patient data from another location, analyzing the data in a trained neural network, producing a diagnostic value, and optionally transmitting the diagnostic value to another location." (Id.)

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Barnhill et al. does not identically disclose the combination of elements recited in independent claim 30, as amended. For example, Barnhill et al. does not identically disclose “generating a plurality of medical statements from a statement library stored in a computer readable database based on clinical measurements, at least some of the plurality of medical statements being associated with a diagnostic predictor” as recited in independent claim 30. In the Final Office Action, the Patent Office asserts that Figures 6-9 show this subject matter from independent claim 30. Applicants note, however, that the data shown in Figures 6-9 is either training data used to train a neural network or testing data used to test the trained neural network. (Barnhill et al., col. 22, line 35 to col. 23, line 33.) Applicants have been unable to locate any description of the data shown in Figures 6-9 of Barnhill et al. as even being generated from a statement library stored in a computer readable database much less being generated from a statement library stored in a computer readable database based on clinical measurements.

Applicants respectfully submit that independent claim 30 and the claims which are dependent thereon are not anticipated by Barnhill et al. under 35 U.S.C. § 102(b) and are patentable.

Claim Rejections – 35 U.S.C. § 103(a)

Law of Obviousness

35 U.S.C. § 103(a), the statutory basis for obviousness rejections, states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1 (1966).

The PTO acknowledges the standard that in order to establish a prima facie case of obviousness, the following criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the cited references must teach or suggest all the claim limitations. (See MPEP § 2143.) Furthermore, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. (See MPEP § 2141.02.)

In proceedings before the Patent and Trademark Office, the Patent Office bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). “[The Patent Office] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Further, satisfying this burden requires the Patent Office to make “particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). In making these findings, the Patent Office must consider each prior art reference in its entirety, including portions that would lead away from the claimed invention. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1552, 220 USPQ 303, 312 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)

The Federal Circuit has further cautioned that:

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). "Close adherence to this methodology is especially important in cases where the very case with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" Kotzab, 217 F.3d at 1369, 55 USPQ2d at 1316 (quoting W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" In re Lee 277 F.3d at 1344, 61 USPQ2d at 1434 (quoting W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Independent Claims 1, 10, and 36

On page 10 of the Office Action, independent claims 1, 10, and 36 and various dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,823,949 (Goltra) in view of U.S. Application Publication No. 2001/0029455 (Chin et al.).

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Applicants respectfully traverse the rejection. None of the cited references, alone or in combination, disclose, teach, or suggest the subject matter recited in independent claims 1, 10, or 36.

Goltra shows “a method and apparatus for helping healthcare professionals create clinical protocols or assist in direct entry of medical finding [sic] into a chart by intelligently prompting a healthcare professional with medical findings associated with at least one medical finding which has already been entered in the protocol is disclosed.” (Goltra, abstract.) This can be accomplished by entering at least one medical finding for a patient into the system where each finding is assigned a point value for each diagnosis within a knowledge base. (Id.) “A total number of points for each diagnosis is then totaled for all of the findings which have been entered into the system. The possible diagnoses are then ranked in descending point total and a predetermined plurality of the highest ranked diagnoses are selected. Once the highest ranked diagnoses have been selected, the healthcare professional is prompted with additional findings associated with the selected diagnoses which have not yet been inputted into the clinical protocol.” (Id.)

Chin et al. shows a “method for electronically translating text” where source text in one language is received as input to an electronic translator. (Chin et al., abstract.) The source text is translated by the electronic translator into one or more target language texts. (Id.) The electronic translator may be used to translate HTML pages so that the translated HTML page shows both the original text and the translation of the text without disrupting the form of the page. (Chin et al., pg. 11, ¶¶ 190, 204.) This is accomplished by carefully positioning the insertion of translations at strategic locations within the page so that they do not significantly shift or displace original content. (Chin et al., pg. 11, ¶ 204.) A two pass process is used to correctly position the translations. The two pass process consists of (1) inserting translation placeholders in places where translations should be later added while at the same time extracting text that needs to be translated and (2) inserting the translations of the text in place of the placeholders. (Chin et al., pg. 11, ¶¶ 205-208.) A tutorial daemon may also be used to analyze the source text and provide feedback identifying possible sources of translation error. (Chin et al., pgs. 13-14, ¶

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

234.) The tutorial daemon may include a grammar checker that is capable of attaching part-of-speech tags to each word to see if any unlikely tag sequences appear. (Chin et al., pg. 14, ¶ 237.) The user can be notified of any unlikely tag sequences so that the user can rephrase the source text, if possible. (Id.)

Independent claim 1

Applicants initially note that claim 1 recites, among other limitations, "associating each statement from a second plurality of statements from the statement library with a plurality of statement attributes including a statement attribute that denotes a grammatical characteristic of speech," which is not disclosed in Goltra. Recognizing this, the Patent Office asserts that it would be obvious to "modify Goltra's method wherein it associates a pa[rt] of speech attribute with a plurality of statements, to notify the user of any possible changes or suggestions." (Final Office Action, pg. 11.)

Applicants respectfully submit that the Patent Office has failed to make a prima facie case of obviousness because the Patent Office has failed to provide "particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (holding that the Patent Office must make "particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). In the Final Office Action, the Patent Office asserts that the motivation for using the part-of-speech tags in the method Goltra is to "notify the user of any possible changes or suggestions." Applicants respectfully submit that it is unclear what "changes or suggestions" the Patent Office is referring to.

Furthermore, as explained previously, the purpose of the part-of-speech tags in Chin et al. is to identify any unlikely tag sequences in source text so that the user can be alerted and the source text rephrased. (Chin et al., pg. 14, ¶¶ 234-237.) The problem being solved by the part-of-speech tags in Chin et al. is not a problem that is present in Goltra. Thus, there is no

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

motivation for combining the two reference in the manner asserted by the Patent Office. To the extent the Patent Office disagrees, the Patent Office is required to provide the "particular findings" to show the motivation to combine the two references.

Applicants further note that Goltra does not appear to describe any sort of the combining or other use of the "medical findings" or "diagnoses" so that the use of the part-of-speech tags from Chin et al would be helpful. Again, to the extent the Patent Office disagrees, the Patent Office must provide the required "particular findings" why the skilled artisan, with no knowledge of the claimed invention, would be motivated to combine these two references in the manner asserted in the Final Office Action.

Independent claim 10

Applicants initially note that claim 10 recites, among other limitations, "accessing a group of statements" and "selecting a statement from the group of statements" wherein "the statement includes a data entry field which allows a user to enter data into the statement," which is not disclosed in Goltra. Recognizing this, the Patent Office asserts that it would be obvious to "modify Goltra's method . . . wherein it provides a statement including a placeholder, to allow information to be later added." (Final Office Action, pg. 11.)

Applicants respectfully submit that the Patent Office has failed to make a prima facie case of obviousness because the Patent Office has failed to provide "particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (holding that the Patent Office must make "particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). In the Final Office Action, the Patent Office asserts that the motivation for using the part-of-speech tags in the method Goltra is to "allow information to be added later." The purpose of the "placeholders" in Chin et al. is to allow the translated text of an HTML page to be "inserted into the page in a way that does not disrupt the page's original look and feel." (Chin et al., pg. 12, ¶ 208.) No such

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

need exists in Goltra. The Patent Office has failed to explain why one of ordinary skill in the art would be motivated to add the placeholders in Goltra when Goltra does not disclose that it would be desirable to “allow information to be added later” to the “medical findings” or “diagnoses.” Since neither the “medical findings” nor the “diagnoses” in Goltra are disclosed as being translated or included as part of an HTML page, the purpose for using the placeholders in Chin et al. is inapplicable to Goltra. Thus, Applicants respectfully submit that there is no motivation for combining the two reference in the manner asserted by the Patent Office. To the extent the Patent Office disagrees, the Patent Office is required to provide the “particular findings” to show why one ordinary skill in the art, with no knowledge of the invention, would be motivated to combine the two references in the manner asserted in the Final Office Action.

Independent claim 36

Applicants initially note that claim 36 recites, among other limitations, “accessing a group of statements using a keyword which is associated with the group of statements” and “providing a listing of reports associated with the statements from the group of statements,” which is not disclosed in Goltra. Applicants also note that although the rejection has been styled as an obviousness rejection under 35 U.S.C. § 103(a), the Patent Office relies exclusively on Goltra to show all the limitations of claim 36. However, it does not matter whether claim 36 was rejected under § 102 or § 103, since neither Goltra alone nor in combination with Chin et al. discloses all of the limitations of claim 36.

Applicants respectfully submit that Goltra either alone or in combination with Chin et al. would not result in the subject matter recited in independent claim 36, as amended, because neither Goltra nor Chin et al. disclose, teach or suggest “accessing a group of statements using a keyword which is associated with the group of statements” and “providing a listing of reports associated with the statements from the group of statements.” On page 12 of the Final Office Action, the Patent Office asserts that the accessing step is shown in Goltra as the codes (e.g., SYM, HIS, etc.) used to divide up the medical findings into categories, and the providing step is shown in the passage at col. 4, lines 20-27, which describes the diagnoses stored in the knowledge base file.

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

Applicants initially note that the passage relied on as showing the accessing step does not show that the medical findings can be accessed using the codes (e.g., SYM, HIS, etc.). Rather, it simply states that they are divided into categories. Furthermore, Goltra explains one reason for dividing the medical findings into categories (other than to allow access to the group of statements in each category via the respective code) is so that "upon selection of the medical findings for the clinical protocol, the entered information is automatically structured in the protocol in the same format as the medical database used to build the protocols, i.e., divided into specific sections. (Goltra, col. 4, lines 44-48.)

Furthermore, Applicants respectfully submit that the passage at col. 4, lines 20-27 does not show "providing a listing of reports associated with the statements from the group of statements." Even assuming that the user could access a category of medical findings using the respective code for a particular category, which is what the Patent Office seems to contemplate as satisfying the "accessing" limitation of claim 36, the passage at col. 4, lines 20-27 does not disclose providing a listing of reports associated with the medical findings from the particular category. Rather, the passage at col. 4, lines 20-27 describes that the *diagnoses* include various information. To the extent that the Patent Office further maintains the rejection of claim 36, Applicants request clarification of how Goltra and/or Chin et al. is being interpreted to show the limitations of claim 36

Applicants respectfully submit that the subject matter recited in independent claims 1, 10, and 36 and the claims which are dependent thereon, considered as a whole, would not have been obvious to a person of skill in the art and are patentable. Accordingly, Applicants request withdrawal of the rejection of the claims under 35 U.S.C. § 103(a).

* * *

Applicants respectfully submit that the present Application is in condition for allowance. Applicants request reconsideration and allowance of the pending claims.

Atty Dkt. No. 070191-0286 (31-CD-5666)

Application No. 09/748,660

The Examiner is invited to contact the undersigned by telephone if the Examiner needs anything or if a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447,

Respectfully submitted,

Date Nov 29, 2005By Scott C. Nielson

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5718
Facsimile: (414) 297-4900

Scott C. Nielson
Attorney for Applicant
Registration No. 50,755